UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,309	12/12/2003	James Harold Gray	BS 02280	2225

38516   7590   09/08/2008
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EXAMINER
SALTARELLI, DOMINIC D

ART UNIT	PAPER NUMBER
2623	

MAIL DATE	DELIVERY MODE
09/08/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/735,309	GRAY ET AL.
	Examiner	Art Unit	
	DOMINIC D. SALTARELLI	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 June 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-38* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments with respect to claims 1-31 have been considered but are

moot in view of the new grounds of rejection.

Double Patenting

2.   A rejection based on double patenting of the "same invention" type finds its
support in the language of 35 U.S.C. 101 which states that "whoever invents or
discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis
added). Thus, the term "same invention," in this context, means an invention drawn to
identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re
Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164
USPQ 619 (CCPA 1970).

      A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by
canceling or amending the conflicting claims so they are no longer coextensive in
scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection
based upon 35 U.S.C. 101.

3.   Claim 32 is provisionally rejected under 35 U.S.C. 101 as claiming the same

invention as that of claim 1 of copending Application No. 11/262,329. This is a

<u>provisional</u> double patenting rejection since the conflicting claims have not in fact been

patented.

4.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

5.   Claims 33-38 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claim 1-9, 13, and 15 of

copending Application No. 11/262,329. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the only functional difference

between the instant application and copending application 11/262,329 is the instant

application performs a look-up to also determine whether the subscriber commands

should be stored at both the media device and the network location, which is not itself a

patentably distinct feature.

This is a <u>provisional</u> obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

6.   Claims 1-31 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing

to comply with the enablement requirement. The claims contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the

invention.

Each of the independent claims, 1, 14, 23, 28, 29, 30, and 31 recite "performing a look-up to determine whether the first user command is locally stored in the viewer appliance, remotely stored at a network location, or stored in both the viewer appliance and in the network location". There is no support in the specification which shows determining if input commands are already stored in memory. The examiner will interpret the claim limitations in light of the specification, and assume the applicant intended the claim language to mean performing the look-up to determine whether the command is *to be* stored locally, remotely, or both. Consequently, dependent claims 2-13, 15-22, and 24-26 are also rejected under 35 U.S.C. 112, first paragraph.

Further, regarding claims 30 and 31, the claims are method claims reciting receiving a user command and performing the claimed look-up procedure. However, the order in which the steps are presented teach that said look-up occurs at the remote location. There is no support in the specification which shows said look-up occurring at a remote location, as the look-up procedure necessarily precludes sending the command to the remote location, because it first must be determined that said command should be sent to the remote location before the command is received at the remote location. The examiner will interpret the claim limitations in light of the specification, and consider the look-up procedure to occur at the viewer's receiver prior to sending the command to the remote location.

Lastly, regarding claim 35, the claim recites determining if a first subscriber command is not to be stored locally, then forwarding the second subscriber command from the device. There is no support in the specification for using the determination

related to a first command to control where a second command is stored or executed.

The examiner will interpret the claim in light of the specification and assume the

applicant intended to state that if a *second* subscriber command is not to be stored

locally, then forwarding the second subscriber command from the device.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Gudorf et al. (US 2003/0110489 A1, of record) [Gudorf] in view of Youden et al.

(5,606,359) [Youden] and Hasselberg et al. (6,286,042) [Hasselberg].

Regarding claims 1-6, 9, 14-18, 23, 24, 27, 28, 29, 30, and 31, Gudorf

discloses a method and system for capturing user commands from a viewer that

are related to viewing content (figs. 1 and 2), comprising:

locally storing user commands which alter aspects of the content viewed

by the viewer in the viewer appliance (paragraph 0022);

relative to receiving the commands, concurrently storing information

related to the user commands at the viewer appliance, the information related to

the user commands including a date and time of receipt (clickstream commands

are time stamped, paragraph 0022); and

executing the user commands at the viewer appliance to alter aspects of

the content being viewed by the viewer while the information related to the

commands continues to be stored at the viewer appliance (commands include

channel change and volume change commands, paragraphs 0022-0024).

Gudorf fails to disclose performing a look-up to determine whether the

user commands are to be locally stored in the viewer appliance, remotely stored

at a network location, or stored in both the viewer appliance and in the network

location, and remotely storing the first user command at the network location

when remote storage is determined or both locally can remotely storing the user

commands when local storage and remote storage is determined.

In an analogous art, Youden teaches providing interactive, on-demand

programming to users from a remote location, requiring those commands which

control said programming to be sent to the remote location (col. 10 line 34 - col.

11 line 3 and col. 13 line 65 - col. 14 line 26), providing the benefit of video on

demand services (col. 1, lines 10-26).

It would have been obvious at the time to a person of ordinary skill in the

art to modify the method and system of Gudorf to include interactive, on-demand

programming to users from a remote location, requiring those commands which

control said programming to be sent to the remote location, as taught by Youden,

for the benefit or providing video on demand services, a service known to be

desired by broadcast customers. Since the commands which define the

clickstream for video on demand applications must be sent upstream (such as

the request itself, and VCR style commands), a determination must be performed

to decided where the commands are to be stored, since for example, a request to

fast forward a video on demand program from a remote location would be

meaningless to the receiver alone, and must be sent upstream to the remote

location.

Gudorf and Youden fail to disclose determining is the commands are to be

both locally and remotely stored and remotely storing the user commands when

local storage and remote storage is determined.

In an analogous art, Hasselberg discloses a system for redundantly

storing sensitive data in two different locations (col. 1, lines 60-67 and col. 5,

lines 40-65), as it is known and desirable to replicate certain items of information

in managed systems across two or more devices (col. 1, lines 25-34).

It would have been obvious at the time to a person of ordinary skill in the

art to modify the method and system of Gudorf and Youden to include

redundantly storing certain user commands at the two locations (locally and

remotely), as taught by Hasselberg.

Regarding claims 7, 19, 20, and 22, Gudorf, Youden, and Hasselberg

disclose the method of claims 1 and 14, further comprising receiving a second

user command and determining a result of the second user command relative to

a present context and including the result in the information related to the second

user command that is forwarded from the viewer appliance (commands include

relative changes in volume and channel changes, Gudorf, paragraph 0024).

Regarding claims 8, 10, 21, 25, and 26, Gudorf, Youden, and Hasselberg

disclose the method and system of claims 1, 9, 18, and 23, wherein the

commands are received at a set-top box integrated with a television (Gudorf,

paragraph 0017).

Regarding claims 11-13, Gudorf, Youden, and Hasselberg disclose the

method of claim 1, and further disclose forwarding the information related to the

user commands after a pre-determined period of time from the viewer appliance

to a remote location where it is use for targeted advertising (Gudorf, paragraph

26, lines 1-4).

9.   Claims 32 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Gudorf in view of Youden.

Regarding claim 32, Gudorf discloses a method of collecting subscriber

commands related to viewing content, comprising:

receiving a first subscriber command and concurrently locally storing an

event record at a media device, the event record comprising an identification

code corresponding to the first subscriber command, and a time stamp that

records a time of occurrence of the first subscriber command (paragraph 0022).

Gudorf fails to disclose the first subscriber command has an application

identifier corresponding to a particular application to which the first subscriber

command is addressed, wherein the event record includes the application

identifier, and subsequently receiving a second subscriber command at the

media device and concurrently forwarding the second subscriber command from

the media device to a component remotely located from the media device.

In an analogous art, Youden teaches providing interactive, on-demand

programming to users from a remote location, requiring those commands which

control said programming to be sent to the remote location (col. 10 line 34 - col.

11 line 3 and col. 13 line 65 - col. 14 line 26), providing the benefit of video on

demand services (col. 1, lines 10-26).

It would have been obvious at the time to a person of ordinary skill in the

art to modify the method and system of Gudorf to include interactive, on-demand

programming to users from a remote location, requiring those commands which

control said programming to be sent to the remote location, as taught by Youden,

for the benefit or providing video on demand services, a service known to be

desired by broadcast customers. Since the commands which define the

clickstream for video on demand applications are destined for the video on

demand server rather than for controlling the local tuner (Youden, col.10, lines

34-45 and col. 10 line 67 - col. 11 line 3), tracking this activity requires adding an

application identifier to the command and the event record, as desired by Gudorf

(who teaches tracking the specifics what a user watches and does to determine

viewing habits, paragraph 0024). Further, those commands specific to the video

on demand application correspond to the claimed second command which is

forwarded to a remote component, as the commands are sent upstream to a real

time controller (Youden, real time controller 60, fig. 2).

Regarding claim 36, Gudorf and Youden disclose the method of claim 32,

and further disclose forwarding the information related to the user commands

after a pre-determined period of time from the media device (Gudorf, paragraph

26, lines 1-4).

Regarding claims 37 and 38, Gudorf and Youden disclose the method of

claim 32, further comprising receiving a second user command and determining

a result of the second user command relative to a present context and including

the result in the information related to the second user command that is

forwarded from the media device (commands include relative changes in volume

and channel changes, Gudorf, paragraph 0024).

10.   Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Gudorf and Youden as applied to claim 32 above, and further in view of Hasselberg.

Regarding claim 33, Gudorf and Youden disclose the method of claim 32,

wherein the method comprises performing a look-up to determine whether the

first subscriber command is to be locally stored at the media device or remotely

stored at a network location, since the commands which define the clickstream

for video on demand applications must be sent upstream (such as the request

itself, and VCR style commands), a determination must be performed to decided

where the commands are to be stored, since for example, a request to fast

forward a video on demand program from a remote location would be

meaningless to the receiver alone, and must be sent upstream to the remote

location.

Gudorm and Youden fail to disclose determining whether the first

subscriber command is to be stored at both the media device and in the network

location.

In an analogous art, Hasselberg discloses a system for redundantly

storing sensitive data in two different locations (col. 1, lines 60-67 and col. 5,

lines 40-65), as it is known and desirable to replicate certain items of information

in managed systems across two or more devices (col. 1, lines 25-34).

It would have been obvious at the time to a person of ordinary skill in the

art to modify the method and system of Gudorf and Youden to include

redundantly storing certain user commands at the two locations (locally and

remotely), as taught by Hasselberg.

Regarding claims 34 and 35, Gudorf, Youden, and Hasselberg disclose

the method of claim 33, wherein when the first or second subscriber command is

to be remotely stored at the network location (that is, not to be stored locally),

then the first or second subscriber command, respectively, is forwarded from the device to the network location (when the command relate to video on demand applications, they are sent upstream, Youden, col. 10, lines 34-45 and col. 10 line 66 - col. 11 line 3).

Conclusion

11.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOMINIC D. SALTARELLI whose telephone number is (571)272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dominic D Saltarelli/
Examiner, Art Unit 2623